

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed November 2, 2004. At the time of the Office Action Claims 1-33 of the present application were pending. Claims 1-33 were rejected by the Final Office Action. Applicants believe that Claims 1-33 are in condition for allowance and respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Office Action rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,453,022 issued to Weinman, Jr. ("Weinman"). Applicants respectfully traverse these rejections for the reasons discussed below.

Claim 12 recites (*with emphasis added*):

A method for managing incoming and outgoing calls when an endpoint has been placed on hold, comprising:

establishing, over a first phone line of a first endpoint, a first call on a network between the first endpoint and a second endpoint, the first call including an outbound media stream communicated from the first endpoint;

detecting that the first call was placed on hold by the second endpoint;

establishing, over a second phone line of the first endpoint, a second call on the network between the first endpoint and a third endpoint after detecting that the first call was placed on hold;

communicating the outbound media stream in the second call;

mixing a first incoming media stream from the first call with a second incoming media stream from the second call for presentation to a user of the first endpoint;

wherein establishing the first call on the network between the first endpoint and the second endpoint comprises receiving signaling information at the first and second endpoints from a call manager coupled to the network; and

wherein detecting that the first call was placed on hold by the second endpoint comprises receiving a signal communicated from the second endpoint to the call manager via the network indicating that the first call was placed on hold.

In order to establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). In rejecting Claim 12, the Office Action states that a user of telephone system 105 of *Weinman* reads on the first endpoint of the present application. The Office Action also asserts that telephone system 105 of *Weinman* reads on the call manager of the present

application. Applicants respectfully assert that the examiner has mischaracterized the teachings of the *Weinman* reference and the elements of the present Claims.

Specifically, Claim 12 recites a first endpoint and a user of the first endpoint. Classifying the user of *Weinman* as a first endpoint ignores the Claim element of a user of the first endpoint. Therefore, Applicants respectfully submit that the user of *Weinman* does not satisfy the claim element of a first endpoint. Moreover, if telephone system 105 of *Weinman* is a call manager, as the Office Action contends, then *Weinman* has not disclosed a first endpoint. Alternatively, if telephone system 105 of *Weinman* is assumed, for arguments sake only, to satisfy the Claim element “first endpoint”, then *Weinman* has not illustrated a call manager.

Further, the teachings of *Weinman* do not disclose, teach, or suggest an element with the interoperability of the call manager as recited in Claim 12. *Weinman* discloses a multi-line telephone 110 coupled to one or more telephone lines 121 and 122 and coupled to a central office 120 of a standard public telephony network 125. See *Weinman*, column 3, lines 20-31; figure 1. *Weinman* does not disclose, teach, or suggest a signal communicated from the second endpoint to a call manager via the network indicating that the first call was placed on hold. *Weinman* also does not disclose, teach, or suggest receiving signaling information at the first and second endpoints from a call manager. For at least these reasons, Applicants respectfully submit that Claim 12 is patentably distinguishable from the *Weinman* reference and request the rejection of Claim 12 be withdrawn.

The Office Action rejects Claims 1-11 and 13-33 under 35 U.S.C. § 103(a) as being unpatentable over *Weinman* in view of U.S. Patent No. 6,785,560 issued to Chow et al. (“*Chow*”). Applicants respectfully traverse these rejections for the reasons discussed below.

Claim 1 recites:

A method for managing incoming and outgoing calls when an endpoint has been placed on hold, comprising:

establishing, over a first phone line of a first endpoint, a first call on a packet switched network between the first endpoint and a second endpoint, the first call including an outbound media stream communicated from the first endpoint;

detecting that the first call was placed on hold by the second endpoint;

establishing, over a second phone line of the first endpoint, a second call on the packet switched network between the first endpoint and a third endpoint after detecting that the first call was placed on hold;
communicating the outbound media stream in the second call; and
mixing a first incoming media stream from the first call with a second incoming media stream from the second call for presentation to a user of the first endpoint.

Applicants respectfully contend that the rejection of Claim 1 is improper, since the Office Action applies hindsight reconstruction to arrive at Applicants' invention, and provides no proper motivation to make the proposed combination. First of all, it is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988). It is also improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Regarding Claim 1, the Office Action states that "it would have been obvious to one of ordinary skill in the art to incorporate the packet switched network, as taught by *Chow*, in *Weinman's* system in order to have a conference system that allows selective audio control within a packet switched network."

The Federal Circuit has held that broad conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Instead, the Examiner must explain the specific understanding or principle within the knowledge of the skilled artisan that would motivate the combination. *See id.* Even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the claimed combination. *See ASC Hospital Systems, Inc.* Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *See Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200 (Fed. Cir. 1991). The Office action has proven the existence of packet switched networks by citing *Chow*. However, the Office Action fails to cite the specific understanding or principle within *Weinman* that would motivate the combination with *Chow*.

Furthermore, even if the Examiner had been able to point to specific motivation to combine the references, the combination of the multi-line telephone system of *Weinman* with the packet switched network of *Chow* would render the multi-line telephone system of *Weinman* inoperable for its intended purpose. Multi-line telephone system 105 of *Weinman* is designed to be coupled to a central office 120 of a standard public telephony network 125. *See Weinman*, column 3, lines 29-31; figure 1. Coupling multi-line telephone system 105 to a packet switched network would make multi-line telephone system 105 incapable of “placing calls to or receiving calls from two or more calling parties at telephones 130 and 135,” as multi-line telephone 105 cannot communicate over a packet switched network. *See Weinman*, column 3, lines 34-36; figure 1.

Each of Claims 11, 14, 21, 28, and 33 include limitations related to establishing calls over a packet switched network. As discussed above with regard to Claim 1, the cited portions of *Weinman* and *Chow* do not disclose each of these limitations, for example, for similar reasons as those discussed above with regard to Claim 1. Therefore, Claims 11, 14, 21, 28, and 33 are believed to be patentably distinguishable from the cited portions of the *Weinman* reference.

Claims 2-10 and 13 depend from, and incorporate all the limitations of, independent Claim 1. Claims 15-20 depend from, and incorporate all the limitations of, independent Claim 14. Claims 22-27 depend from, and incorporate all the limitations of, independent Claim 21. Claims 29-32 depend from, and incorporate all the limitations of, independent Claim 28. Therefore, Applicants respectfully submit that Claims 2-10, 13, 15-20, 22-27, and 29-32 are patentably distinguishable from the cited art, for example, for the same reasons discussed above with regard to Claims 1, 14, 21, and 28.

The Office Action also states that *Chow* teaches that the call hold button can act similar to a call mute button when a call is placed on hold by pressing the hold button twice quickly to adjust the volume or mute the calling party. Initially, Applicant’s respectfully submit that the Examiner has mischaracterized *Chow*. *Chow* does not disclose adjusting the volume or muting the calling party, but instead discloses muting the called party. Outbound voice traffic from the called party is muted to the calling party, which may hear only white comfort noise. *See Chow*, column 42, lines 39-53. Additionally, Applicants contend that *Chow* does not disclose adjusting the volume of the calling party. The present application

includes Claims, such as Claim 2, which include generating a mixed media stream including a first percentage of the first incoming media stream and a second percentage of the second incoming media stream. *Chow* does not disclose adjusting incoming media streams. For at least these additional reasons, Applicants respectfully submit that the Claims of the present Application are patentably distinguishable from the *Chow* reference.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fees are currently due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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